

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

To:

see form PCT/ISA/220

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/EP2004/050036

International filing date (day/month/year)
22.01.2004

Priority date (day/month/year)
22.01.2003

International Patent Classification (IPC) or both national classification and IPC
H04Q7/36

Applicant
MOTOROLA INC

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☒ Box No. II Priority
- ☒ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

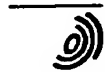
If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

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**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

10/541098
JC20 Rec'd PCT/PTO 28 JUN 2005
International application No.
PCT/EP2004/050036

Box No. 1 Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material:
 - ☐ a sequence listing
 - ☐ table(s) related to the sequence listing
 - b. format of material:
 - ☐ in written format
 - ☐ in computer readable form
 - c. time of filing/furnishing:
 - ☐ contained in the international application as filed.
 - ☐ filed together with the international application in computer readable form.
 - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
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Box No. II Priority

1. ☒ The following document has not been furnished:

- ☒ copy of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(a)).
- ☐ translation of the earlier application whose priority has been claimed (Rule 43*bis*.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date is the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43*bis*.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
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Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

- ☐ the entire international application,
- ☒ claims Nos. 16,17

because:

- ☐ the said international application, or the said claims Nos. relate to the following subject matter which does not require an international preliminary examination (*specify*):
- ☒ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. 16,17 are so unclear that no meaningful opinion could be formed (*specify*):

see separate sheet

- ☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.
- ☒ no international search report has been established for the whole application or for said claims Nos. 16,17
- ☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:
 - the written form ☐ has not been furnished
 - ☐ does not comply with the standard
 - the computer readable form ☐ has not been furnished
 - ☐ does not comply with the standard
- ☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-bis of the Administrative Instructions.
- ☐ See separate sheet for further details

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/EP2004/050036

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	5,6,13,14
	No: Claims	1-4,7-12,15
Inventive step (IS)	Yes: Claims	
	No: Claims	1-15
Industrial applicability (IA)	Yes: Claims	1-15
	No: Claims	

2. Citations and explanations

see separate sheet

Reference is made to the following document:

D1: US 6 442 387 B1

D2: WO 99/02004 A1

Re Item III

Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The current formulation of independent **claims 16 and 17** does not fulfill the requirements of Article 6 PCT as they include an ambiguous reference (i.e. "substantially as hereinbefore described") such that the scope of said claims cannot be precisely determined (see PCT Guidelines, Part II, Chapter 5, Paragraphs 5.32 and 5.38). In particular it is not clear to which technical features the term "as hereinbefore described" refers.
2. In addition, independent **claims 16 and 17** rely on references to drawings (i.e. expression "with reference to accompanying drawings"), which is not acceptable, see Rule 6.2(a) PCT and also PCT Guidelines, Part II, Chapter 5, Paragraph 5.10.
3. Thus, no opinion with regard to novelty, inventive step and industrial applicability is established for **claims 16 and 17** (Article 34(4)(a)(ii) PCT).

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. The present application does not meet the criteria of Article 33(1) PCT, for the following reasons:
2. Document **D1** discloses, according to all the features of **claim 1**, a method for determining frequency planning measurement data (see column 1, lines 58 to 60) in a cellular communications system (see column 2, lines 17 to 21; Figure 1), the

method comprising:

allocating neighbour lists to provide measurement data for frequency planning (see column 2, lines 40 to 54; column 3, lines 1 to 8);
wherein the neighbour lists are allocated on a per call basis (see column 3, lines 9 to 11; claim 2).

The subject-matter of **claim 1** is therefore not new, Article 33(2) PCT.

- 2.1 The same considerations as made in above paragraph 1 regarding **claim 1** are also valid for independent **claims 7 to 9 and 15** since these claims include the same feature combination as **claim 1** in terms of claims relating to a method (**claim 7**), a storage medium (**claim 8**) and an apparatus (**claims 9 and 15**).

The subject-matter of **claims 7 to 9 and 15** is therefore not new, Article 33(2) PCT.

3. It is furthermore pointed out that even if the aforementioned novelty objections in paragraphs 2 and 2.1 were disputed based on minor differences of interpretation between some of the features of **claims 1, 7 to 9 and 15** and the features of document **D1**, the subject-matter of **claims 1, 7 to 9 and 15** would still not involve the required inventive step, Article 33(3) PCT, considering that document **D1** aims at the same object as the present application and discloses the same type of solution.
4. Dependent **claims 2 to 6 and 10 to 14** do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty, Article 33(2) PCT (for **claims 2 to 4 and 10 to 12**), or inventive step, Article 33(3) PCT (for **claims 5, 6, 13 and 14**), for the reason that the subject-matter of said claims is already disclosed in document **D1** (for **claims 2 and 10**: see in particular column 2, lines 41 to 50; claim 5; for **claims 3, 4, 11 and 12**: see in particular column 3, lines 9 to 11; claim 2), or document **D2** (for **claims 5, 6, 13 and 14**: see in particular page 6, line 31 to page 7, line 21).

Further remarks made in respect of the present application

1. Although **claims 1 and 7** have been drafted as separate independent claims, they relate effectively to the same subject-matter and differ from each other only with regard to the definition of the subject-matter for which protection is sought and in respect of the terminology used for the features of that subject-matter. The aforementioned claims therefore lack conciseness.

The same objection applies to independent **claims 9 and 15**.

Hence, **claims 1, 7, 9 and 15** do not meet the requirements of Article 6 PCT.

2. The expression "... to provide measurement data ..." used in **claim 1** is not clear as it does not specify what kind of measurement data (measured by which node) is to be meant. This, however, is considered to be a feature essential for correct understanding of the claimed invention (see also description on page 2, lines 15 to 25), Article 6 PCT in combination with Rule 6.3(b) PCT.

The same objection applies to independent **claim 9**.

3. The term "substantially" used in **claims 3 to 6 and 11 to 14** leaves the reader in doubt as to the exact scope of the corresponding feature, thereby rendering the definition of the subject-matter of said claims unclear (Article 6 PCT; see also PCT Gazette, Part II, Chapter 5, Paragraphs 5.34 and 5.38).